

Amendment
Serial No. 09/842,683
Attorney Docket No. 010589

REMARKS

Claims 12-20 are pending in the application. Claims 6-11 and 21-26 are cancelled.

Claim 13 is amended and no claims are added.

The Examiner stated that the subject matter of the elected claims (12-20) corresponds only to Japanese Patent Application JP 2000-132386. Accordingly, Applicants amend inventorship of this application pursuant to 37 CFR 1.48(b). Please see Amendment of Inventorship on page 7. Kazuhara Maeda, Susumu Takahashi and Toshio Abe are the inventors of the presently pending claims. A check in the amount of \$130.00 is attached for the fees requested under 37 C.F.R. 1.17(i).

The Examiner objected to claim 13 because of a grammatical informality. Accordingly, Applicants amend claim 13. Please see List of Claims on page 2. In view of this, withdrawal of the objection is now solicited.

The Examiner rejected claims 12, 18 and 19 under 35 U.S.C. § 101, whereby the Examiner asserted that the claimed invention is directed to non-statutory subject matter. For the following reasons, Applicants respectfully traverse the Examiner's §101 rejection. The invention as set forth in the written description and claims of the above-identified application is statutory because §101 permits patents to be granted for "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof." The subject matter of claims 12 and 18 (i.e., relates to a parts check list preparing system and method

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for preparing a parts check list) does come within the boundaries set forth by §101. Accordingly, withdrawal of the rejection is now solicited.

The Examiner rejected claims 12, 13, 15 and 18-20 under 35 U.S.C. § 102(e) as being anticipated by *Costello et al.* (U.S. Patent Application Publication 2002/0007225). For the following reasons, Applicants respectfully traverse the Examiner's §102(e) rejections.

Costello et al. fails to disclose all of the limitations of claim 12 of the above-identified application. In particular, *Costello et al.* fails to disclose a parts check list preparing system, comprising a means to automatically prepare the parts check list based on the parts list [claim 12.] Accordingly, withdrawal of the rejection of independent claim 12 is now solicited.

In addition, *Costello et al.* fails to disclose all of the limitations of dependent claim 15 of the above-identified application. In particular, *Costello et al.* fails to disclose a response preparing means which searches through the price table and storage table for the price data and storage data of the parts listed in the parts check list and makes the parts check list select the search result [claim 15.] Accordingly, withdrawal of the rejection of dependent claim 15 is now solicited.

Claims 13, 15, and 18 should be allowable based on their dependency from claim 12.

Method claims 19-20 should likewise be allowable for the reasons discussed above.

The Examiner rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over *Costello et al.* in view of *Joseph et al.* (U.S. Patent No. 6,606,603); claim 16 under 35 U.S.C. § 103(a) as being unpatentable over *Costello et al.* in view of *Rune* (U.S. Patent No. 6,304,913);

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and claim 17 under 35 U.S.C. § 103(a) as being unpatentable over *Costello et al.* and *Rune* and further in view of *Gladney et al.* (U.S. Patent No. 4,714,992). For the reasons discussed above, claims 14, 16 and 17 should be allowable based on their dependency from claim 12.

For at least the foregoing reasons, the claimed invention distinguishes over the cited art and defines patentable subject matter. Favorable reconsideration is earnestly solicited.

Should the Examiner deem that any further action by applicants would be desirable to place the application in condition for allowance, the Examiner is encouraged to telephone applicants' undersigned attorney.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
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